UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE TOGNAZZINI

Appeal No. 2005-1450
Application No. 08/655,136

ON BRIEF

Before HAIRSTON, BARRETT and GROSS, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal[1] from the final rejection of claims 1, 5 through 10, 15 and 21 through 28.

The disclosed invention relates to a method and apparatus for sending information to a called station over a telephone

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[1] In a prior decision dated August 30, 2002 (Appeal No. 2000-0237), the Board reversed the obviousness rejections of claims 1 through 15 and 17 through 20.

line, and for receiving information from a called station over the telephone line.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

> 1. Apparatus for sending information to called stations over a telephone line, comprising:
>
> a. a telephone set connected to said line;
>
> b. a data interface connected to said line;
>
> c. a card reader for reading card information and sending it to one of said called stations over said data interface;
>
> d. data memory for storing information from one of said called stations, including said card information;
>
> e. a key for activating said data memory to send said stored information to another of said called stations; and
>
> f. a docking port for receiving a portable device having device memory therein and for transferring information from said data memory to said device memory.

The references relied on by the examiner are:

Winebaum et al. (Winebaum)	4,941,172	Jul. 10, 1990
Feldman	5,343,519	Aug. 30, 1994
Remillard	5,396,546	Mar. 7, 1995
Sandig et al. (Sandig)	5,737,610	Apr. 7, 1998
	(effective filing date	Feb. 16, 1993)
Rose et al. (Rose)	5,757,917	May 26, 1998
	(filed	Nov. 1, 1995)
Bezos (Bezos '399)	5,715,399	Feb. 3, 1998
	(filed	May 30, 1995)

Dedrick	5,717,923	Feb. 10, 1998 (filed Nov. 3, 1994)
Bezos (Bezos '163)	5,727,163	Mar. 10, 1998 (filed Mar. 30, 1995)

Claims 5 through 10, 15 and 22 through 28 stand rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness.

Claims 1 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rose in view of Sandig and Remillard.

Claims 15 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bezos '399 in view of Bezos '163 and Dedrick.

Claims 5 through 10 and 22 through 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Feldman in view of Winebaum.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we reverse the indefiniteness rejection of claims 5 through 10, 15 and 22 through 28, and reverse the obviousness rejections of claims 1, 15, 21 and 28. On the other hand, we will sustain the obviousness rejection of claims 5 through 10 and 22 through 27.

Turning first to the indefiniteness rejection, the examiner states (answer, pages 6 and 7) that claims 5 and 22 are indefinite because the "seller memory connectable to external memory . . . is not part of the portable device." We agree with the examiner that the external memory and the seller memory are not part of the docking port of the claimed device. We do not, however, agree with the examiner that the presence of these elements in the claims renders them indefinite. The appellant has merely set forth in the claims the source of the information (i.e., the seller memory connectable to the external memory) that is loaded into the device memory, and the intended use[2] of the port and the information that is loaded into the device memory.[3] With respect to claims 15 and 28, the examiner is of the opinion (answer, page 7) that these claims are indefinite because they recite "performing 'sending information stored in said seller

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[2] A statement of intended use does not serve to distinguish structure of the device over the prior art. In re Pearson, 494 F.2d 1399, 1402-03, 181 USPQ 641, 644 (CCPA 1974); In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967).

[3] When a claim is directed to a product-by-process, the patentability of the product is established, and not the process by which the product is made. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). In other words, the patentability of the claimed device does not depend on its method of production to load the information. In re Pilkington, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969).

memory from said telephone at the seller site to said customer memory for use during a subsequent order' steps without first connecting to a user's telephone." The examiner's contention to the contrary notwithstanding, the claims do recite connecting the seller's telephone to the customer's telephone, albeit in the last phrase in each of the claims. Although the placement of this phrase is not ideal, and the claims are not a model of clarity, the skilled artisan would understand that the two telephones have to be connected to order the goods. Thus, the indefiniteness rejection of claims 5 through 10, 15 and 22 through 28 is reversed because the claims do set out and circumscribe a particular area with a reasonable degree of precision and particularity when read by the artisan in light of the disclosure and the relevant prior art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Turning next to the obviousness rejection of claims 1 and 21, appellant argues (brief, page 10) that "the Examiner has not shown that *Rose et al., Sandig et al.,* and *Remillard,* taken alone or together, teach or suggest an apparatus including a data memory for storing information including card information from one called station and a key for activating said data memory to send said stored information to another called station." We

agree with appellant's argument. In Rose, the buyer as well as the seller use the Internet to transact business via their respective computers. Although telephone lines are used in the Internet transaction, Rose is completely silent as to a telephone set, the noted data memory and the key for activating the data memory to send stored information to another called station. In Sandig, data from source database 2 is transferred to computer 3 via server computer 5 (Figure 1). At computer 3, data is loaded onto external card 4 via external drive/loader 6 (column 1, line 66 through column 2, line 12). Again, telephone lines are used, but a telephone set is not used in connection with a data memory and a key for activating the data memory to send stored information to another called station. The remote access system disclosed by Remillard uses telephone lines to connect electronic device 20 and a facility 30 (Figures 1 and 2). Remillard, like Rose and Sandig, does not disclose a telephone set, a data memory or a key for activating the data memory to send stored information to another called station. In summary, the obviousness rejection of claims 1 and 21 is reversed.

With respect to claims 15 and 28, appellant argues (brief, page 13) that "the Examiner has failed to show that *Bezos '399, Bezos '163,* and *Dedrick,* taken alone or together, teach or

suggest a seller telephone that sends information to a customer memory in a customer telephone for use during a subsequent order." We agree with appellant's argument. In Bezos '399, a merchant sends via the Internet a portion of each of the customer's credit card numbers that are on file with the merchant. In a return message, the customer lets the merchant know which card number to use for the transaction (Figure 1; column 5, lines 23 through 45). Bezos '399 uses computers, as opposed to telephones, to complete the transaction. Unlike all of the previously applied references, the customer 10 in Bezos '163 uses a touch-tone telephone to key in a credit card number to complete a transaction with a remote merchant 32 (Figure 1; Abstract). The telephone at the customer's site in Bezos '163 does not possess a memory that receives information from the merchant or any other site. Dedrick dynamically customizes electronic information for an end user (Abstract; column 2, lines 1 through 24). Dedrick is silent as to a telephone with memory for storing specific information. Inasmuch as the applied references neither teach nor would have suggested to the skilled artisan the claimed telephone with memory for storing specific information sent from a seller site, the obviousness rejection of claims 15 and 28 is reversed.

Turning lastly to the obviousness rejection of claims 5 and 22, we agree with the examiner's findings (Answer, pages 11 and 12) concerning the teachings of Feldman and Winebaum. Feldman discloses a device memory 14, a docking port 26,[4] a converter/ control means 16 for converting information from device memory 14 into an audible representation of that information, and a send key 22, 24 (Figures 3 and 4). When the send keys are activated, the audible signal is sent to a called station to access an account to purchase a telephone call (column 3, lines 1 through 9; column 4, lines 25 through 55). Winebaum discloses a similar autodialer that is used to purchase a product (Figure 3; Abstract). Based upon the teachings of Feldman and Winebaum, the obviousness rejection of claims 5 and 22 is sustained. The obviousness rejection of claims 6 through 10 and 23 through 27 is likewise sustained because appellant has chosen to let these claims stand or fall with claims 5 and 22 (brief, page 5).

DECISION

The decision of the examiner rejecting claims 5 through 10, 15 and 22 through 28 under the second paragraph of 35 U.S.C.

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[4] As indicated supra, the patentability of claims 5 and 22 is based on the product per se, and not on the statement of intended use and the product-by-process limitations associated with the docking port of the claimed device.

§ 112 is reversed. The decision of the examiner rejecting claims 1, 5 through 10, 15 and 21 through 28 under 35 U.S.C. § 103(a) is affirmed as to claims 5 through 10 and 22 through 27, and is reversed as to claims 1, 15, 21 and 28.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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LEE E. BARRETT)
Administrative Patent Judge) BOARD OF PATENT APPEALS AND INTERFERENCES
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)
ANITA PELLMAN GROSS)
Administrative Patent Judge)

KWH:hh

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
901 NEW YORK AVE., N.W.
WASHINGTON, D.C. 20001-4413